

## **REMARKS**

### **Status of claims**

Claims 1-5, 7, and 13-21 are pending in the application. Claim 3-4 have been amended. Claim 22 is new. No new matter is added.

### **Claim Rejection -35 U.S.C. § 102(b)**

Claims 1-2, 7, 13-23 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Publication No. ("Cheng"). Applicant respectfully transgresses the rejection.

Claim 1 recites an orthopedic appliance including a substantially rigid structure having an inner surface and an outer surface, the substantially rigid structure having a plurality of holes therethrough at pre-selected locations. The orthopedic appliance also includes a flexible support member having a top layer and a bottom layer. The orthopedic appliance also includes a liner that is affixed to the flexible support member and adapted to be positioned next to the body portion, the liner being of a material that facilitates the transfer of moisture from the body portion out through the holes of the substantially rigid structure to the atmosphere, where the flexible support member is positioned between the substantially rigid structure and the liner.

Applicant submits that Cheng fails to teach or disclose a number of the features of claim 1. Examples are set forth as follows.

#### **A substantially rigid structure**

Applicant submits that Cheng fails to teach, among other things, an orthopedic appliance having a substantially rigid structure having an inner surface and an outer surface, where the substantially rigid structure includes a plurality of holes therethrough at pre-selected locations. The Examiner alleges that Cheng teaches a substantially rigid structure, stating that "Cheng discloses a substantially rigid structure fig. 6 said substantially rigid structure having an inner surface fig. 6 and an outer surface fig.6, said substantially rigid structure having a plurality of holes 115 there through

at pre-selected locations” (Office Action, page 2). The Examiner states that the Cheng’s substantially rigid structure has a plurality of holes 115. But Applicant notes that Cheng’s holes 115 are located in the “wall 123” which is “flexible enough to yield to a certain extent when subjected to forces trying to displace it toward the other of the walls” (Col 6, lines 20-21). This is important because in order for Cheng’s device to function as a shock absorbing and air circulation providing structure, it needs the flexibility of the wall to create an air pumping mechanism. This is explicitly stated in Cheng, “combined with the presence of the conduit 18 and the passage 26... this wall flexibility makes a pumping chamber out of the compartment 22” (Col 6, lines 31-34). The wall 123 is thus not substantially rigid. If the wall 123 were substantially rigid, Cheng’s shoe structure wouldn’t be able to create the air pumping mechanism, thereby defecting the purpose of his device. Thus, contrary to the Examiner’s contention, Cheng does not teach a substantially rigid structure, let alone one having a plurality of holes therethrough it.

A flexible support member and a liner affixed to the flexible support member

Applicant respectfully submits that Cheng also fails to teach, among other things, a flexible support member and a liner affixed to the flexible support member. The Examiner contends that Cheng teaches a flexible support member, stating particularly that Cheng discloses a “flexible support member comprising a top layer and a bottom layer 120” and that the “flexible support member is positioned between the substantially rigid structure and the liner fig 7” (Office Action, page 2). However, Figure 7 shows the corrugated element 120 but the element 120 has no liner. The element 120 cannot be both the liner and the flexible support member, let alone a liner that is affixed to the flexible support member. To interpret the corrugated member 120 as both a flexible support and a liner would eviscerate these two elements of any meaning in the claims. This is improper. According to MPEP 2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant thus respectfully asserts Cheng does not teach each and every element of claim 1.

A liner

Cheng also does not teach or suggest a “liner” that is adapted to be positioned next to a body portion. In Cheng, the wall 123 of the corrugated element 120, rather than a liner, is positioned next to the body portion (See Figure 7). Moreover, Cheng also fails to teach such a liner being of a material that facilitates the transfer of moisture from the body portion out through the holes of a substantially rigid structure to the atmosphere. The Examiner’s position that Cheng does teach such a liner is wholly unsupported. The Examiner provides no support for that position. In fact, Cheng fails to teach any material that is capable of transferring moisture from a body portion, let alone a liner that is adapted to transfer moisture from the body portion out through the holes of the substantially rigid structure to the atmosphere. Applicant respectfully requests that the Examiner either identify, with specificity, what teachings or suggestions are found in Cheng that discloses this feature or withdraw the rejections.

A flexible support member being positioned between a substantially rigid structure and the liner

Claim 1 requires that a flexible support member be positioned between a substantially rigid structure and a liner. As shown in Figure 7, Cheng’s element 120 includes two walls 123 and 124 which, as noted above, are flexible. As shown in Figure 7, no structure is included beyond walls 123 and 124. Therefore Cheng’s element 120 cannot be a flexible support member positioned between a substantially rigid structure and a liner. Moreover, as mentioned above, Cheng fails to teach a liner and a substantially rigid structure, hence he does not teach a flexible support member that is positioned between any such structures.

Accordingly, at least for the foregoing reasons, Applicant requests that the Examiner withdraw the rejection for claim 1 and its dependent claims.

Claim Rejection -35 U.S.C. § 103(a)

Claims 3-5, 8, and 9 are rejected under 35. U.S.C. 103(a) as being unpatentable over Cheng in view of Darby. Cheng, either alone or in combination with Darby, fails to teach all of elements recited in claim 1, which claims 3-5 and 8-9 depend from. Darby discloses a shoe, as shown in Figure 1, that is shaped like a sandal. In fact, Darby calls it a sandal (title). Among other things, Darby's sandal does not include a prosthesis or an orthosis as recited in claims 3 and 4, respectively. Applicant also respectfully asserts that Darby's structure is not an ankle brace, a leg brace, a walking brace, or an arm brace as recited in claim 5. Accordingly, Applicant requests that the Examiner withdraw the rejections of these claims for at least these reasons.

New claim

With respect to claim 22, Applicant respectfully submits that Cheng, either alone or in combination with Darby, fails to teach or suggest an orthopedic appliance having a substantially rigid structure having a pronounced indentation for receiving the malleoli of a user. This claim is fully supported by the originally filed specification. See, for example, Figure 1b and paragraph 29.

Conclusion

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Applicants believe no fee is due with this response other than as reflected on the enclosed Amendment Transmittal. However, if an additional fee is due, please charge our Deposit Account No. 18-1945, under Order No. ACIZ-P01-004 from which the undersigned is authorized to draw.

Dated: May 14, 2009

Respectfully submitted,

By 

Jong Min Park

Registration No.: 63,389

ROPES & GRAY LLP

One International Place

Boston, Massachusetts 02110

(617) 951-7000

(617) 951-7050 (Fax)

Attorneys/Agents For Applicant